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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/539,558	03/31/2000	Alan H. Karp	10992073	9395

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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 05/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/539,558

Applicant(s)

KARP ET AL.

Examiner

Jonathan Ouellette

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Request for Continued Examination

1. The Request filed on 2/24/2004 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/539,558 is acceptable and a RCE has been established. An action on the RCE follows.

Response to Amendment

2. Claims 1-20 have been cancelled and Claims 42-49 have been added; therefore, Claims 21-49 are pending in application 09/539,558.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 21-31 and 33-48 are rejected under 35 U.S.C. 103(a) as being obvious over O'Neil et al. (US 5,987,440).**

5. As per independent Claims 21, 34, and 42, O'Neil discloses a method (system) for selling personal information of an owner to a requestor via the Internet (Fig.1, C2 L8) comprising:
[designating, by the owner, an authorized information source to a trusted party; contacting, by the trusted party, the authorized information source to] obtain the personal information of the

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owner (Abstract, C61 L50-54, C65 L36-39); providing the personal information to a trusted party by the information source after authorization by the owner, wherein the trusted party is different from the owner; providing the personal information to a requestor by the trusted party based on a sale policy that is controlled by the owner (Abstract, C2 L49-63, C6 L53-64, C61 L61-67, C62 L61-67, C63 L1-15, C65 L39-40); providing payment to the trusted party from the requestor; and providing compensation to the owner from the trusted party (Abstract, C6 L53-64, C21 L37-62, C24 L8-45, C62 L61-67).

6. O'Neil fails to expressly disclose wherein the information source may be any user of the Internet.

7. However O'Neil does disclose that the system can be operated on the internet (Fig.1, C2 L8), and can be accessed by anyone on the Internet through the website address (C4 L25-40), wherein any Internet user may sign up to a E-Metro Community based on established rules and regulations (C5 L25-52, C22 L52-58) - which could be established to allow any user on the Internet who makes a request to use the system. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to simply allow anyone on the Internet to use the system (website) discloses by O'Neil, as it would simply be a matter of removing security precautions (registration) - for the purpose of reducing system set-up and operational maintenance costs.

8. As per Claim 22, O'Neil discloses wherein the trusted party and the information source are the same entity (Abstract, C2 L2-64, C61 L50-54, C65 L36-39).

9. As per Claims 23 and 43, O'Neil discloses specifying the sale policy by the owner (Abstract, C10 L11-16, C24 L8-45, C65 L50-55, C67 L7-10).

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10. As per Claims 24, 35, and 44, O'Neil discloses specifying attributes required of a requestor in order to receive the personal information (Abstract, C10 L11-16, C24 L8-45, C65 L50-55, C67 L7-10).
11. As per Claims 25, 36, and 45, O'Neil discloses specifying exclusions related to the sale of the personal information (Abstract, C24 L8-45, C67 L7-10).
12. As per Claims 26, 37, and 46, O'Neil discloses specifying cost of the personal information by the owner, and wherein the providing the personal information to a requestor comprises selectively providing the validated personal information based upon the cost (Abstract, C6 L53-64, C21 L37-62, C24 L8-45, C61 L55-60).
13. As per Claims 27, 38, and 47, O'Neil discloses assessing the cost to a requestor submitting the request (Abstract, C6 L53-64, C21 L37-62, C24 L8-45).
14. As per Claims 28 and 39, O'Neil discloses crediting a least a portion of the cost to the owner (Abstract, C6 L53-64, C21 L37-62, C24 L8-45, C62 L61-67).
15. As per Claim 29, O'Neil discloses crediting an account associated with the owner (Abstract, C6 L53-64, C21 L37-62, C24 L8-45, C62 L61-67).
16. As per Claims 30, 40, and 48, O'Neil discloses obtaining information related to credit card purchases, shopping habits, web browsing habits, assets, or finances of the owner (Abstract, C6 L53-64, C10 L23-36).
17. As per Claims 31 and 41, O'Neil discloses recording an indication of electronic purchases by the owner (C6 L53-64, C10 L23-36, C21 L59-62, C63 L34-38).
18. As per Claim 33, O'Neil discloses receiving a request to search for a particular owner having personal information for sale by the trusted party (C20 L1-20, C24 L18-25, Figs. 28-33)

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19. **Claims 32 and 49 is rejected under 35 U.S.C. 103(a) as being obvious over O'Neil et al.**

20. As per Claims 32 and 49, O'Neil discloses enabling the requestor to decline receipt of the personal information based upon a cost of the personal information; and wherein providing the personal information to the requestor comprises providing the personal information to the requestor if the requestor has not declined receipt of the personal information.

21. O'Neil does not specifically disclose enabling the requestor to decline receipt of the personal information based upon a cost of the personal information.

22. However, O'Neil does teach that the buyer (requestor) has the right to collectively bargain collective and individual personal information processing privileges in exchange for value (C67 L62-67, C68 L1-5).

23. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included enabling the requestor to decline receipt of the personal information based upon a cost of the personal information in the system disclosed by O'Neil, for the advantage of providing a method for selling personal information, which gives the buyer bargaining power to decide whether to purchase the personal information or not based on the seller's price.

Response to Arguments

24. Applicant's arguments with respect to Claims 21-49 have been considered have been fully considered but they are not persuasive.

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25. The Applicant argues that the prior art fails to disclose or suggest wherein the information source may be any user of the Internet.

26. O'Neil presentation of a community information exchange, would be an improvement over the claimed invention. O'Neil specifically describes the need for closed system "Community" on the Internet, as an improvement to an "open system", in order to increase the security and exchange of personal information (C1 L29-59).

27. Furthermore, as explained in the rejection above, O'Neil does disclose that the system can be operated on the internet (Fig.1, C2 L8, **C4 L25-30**), and can be accessed by anyone on the Internet through the website address (**C4 L25-40**), wherein any Internet user may sign up to a E-Metro Community based on established rules and regulations (**C5 L25-52, C22 L52-58**) - which could be established to allow any user on the Internet who makes a request to use the system. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to simply allow anyone on the Internet to use the system (website) discloses by O'Neil, as it would simply be a matter of removing security precautions (registration) - for the purpose of reducing system set-up and operational maintenance costs.

28. The applicant also makes the argument that the prior art fails to disclose or suggest enabling the requestor to decline receipt of the personal information based upon a cost of the personal information.

29. However, as explained in the rejection above, O'Neil does teach that the buyer (requestor) has the right to collectively bargain collective and individual personal information processing privileges in exchange for value (**C67 L62-67, C68 L1-5**).

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30. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included enabling the requestor to decline receipt of the personal information based upon a cost of the personal information in the system disclosed by O'Neil, for the advantage of providing a method for selling personal information, which gives the buyer bargaining power to decide whether to purchase the personal information or not based on the seller's price.

31. Finally, all claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

32. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Conclusion

33. Additional Non-Patent Literature has been referenced on the attached PTO-892 form, and the Examiner suggests the applicant review these documents before submitting any amendments.

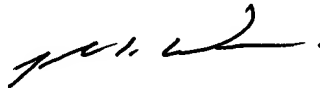
34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662.

The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

35. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.

36. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

jo
May 20, 2004


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600